

**REMARKS**

The Examiner is thanked for his Office Action.

Claims 1-21 are pending in the application, and were each rejected. All rejections are traversed below.

Reconsideration of the claims is respectfully requested.

**I. CLAIM REJECTIONS -- 35 U.S.C. § 102**

Claims 1-8, 10-17 and 19-20 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,151,074 to *Werner*, hereinafter “Werner”. This rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131, p. 2100-76 (8th ed., rev. 4, October 2005) (*citing In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990)). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. *Id.* (*citing Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987)).

Claim 1 requires, among other limitations, “a controller capable of dividing the digital still image file into a plurality of sub-picture files, the controller further capable of constructing an MPEG video stream from the plurality of sub-picture files” (emphasis added). This feature is not taught or suggested at all by Werner. Werner does mention in col. 5 that it “can be” for still or full-motion

decompression algorithms, but does not then teach anything concerning a still image decompression algorithm.

Specifically, at no point does Werner teach or suggest anything related to dividing a still image file into a plurality of sub-picture files. In fact, Werner doesn't teach anything about files at all. Werner clearly cannot anticipate independent claim 1 or dependent claims 2-9.

Claim 11 includes similar language, and so Werner also does not anticipate independent claim 11 or dependent claims 12-18. Claim 18 requires dividing a digital still image file into a plurality of sub-picture files, and so Werner similarly cannot anticipate independent claims 19 or dependent claims 20-21.

Accordingly, the Applicant respectfully requests the Examiner to withdraw the § 102 rejection with respect to these claims.

As such, all claims distinguish over Werner.

## **II. CLAIM REJECTIONS -- 35 U.S.C. § 103**

Claims 9, 18 and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Werner in view of U.S. Patent No. 6,728,317 to *Demos*, hereinafter "Demos". The Applicant(s) respectfully traverse the rejection.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142, p. 2100-133 (8th ed. rev. 4, October 2005). Absent such a *prima facie* case, the applicant is under no obligation to produce evidence of nonobviousness. *Id.* To establish a *prima facie* case of obviousness, three basic criteria must be

met: *Id.* First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *Id.* Second, there must be a reasonable expectation of success. *Id.* Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *Id.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *Id.*

Demos similarly fails to teach or suggest anything related to dividing a still image file into a plurality of sub-picture files, and so cannot teach or suggest the limitation that is missing from Werner. As neither Werner nor Demos teach or suggest this or similar features as required by each independent claim, neither can any combination of these references meet the limitations of the claims.

Accordingly, the Applicant respectfully requests the Examiner to withdraw the § 103 rejection with respect to these claims.

All rejections are traversed, and reconsideration and allowance are respectfully requested.

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**CONCLUSION**

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

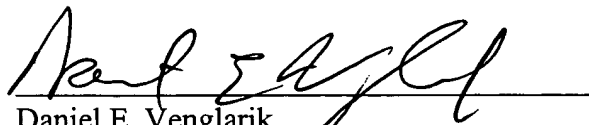
If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *dvenglarik@munckbutrus.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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